

## **REMARKS/ARGUMENTS**

Claims 19-29 are pending in the present application. Claims 6-8 and 14-18 are canceled. Claims 19-29 are new. Support for the new claims can be found in the Specification on page 9, lines 15, 23-24, and 28-30, page 10, lines 28-29, page 12, line 6, page 14, lines 3-4, page 16, lines 26-29, page 18, line 30, and page 19, lines 10-13. No new matter is added by any of the amendments. Reconsideration of the claims is respectfully requested.

Applicant has canceled claims 6-8 and 14-18. Applicant does not concede that the subject matter encompassed by the earlier presented claims is not patentable over the art cited by the Examiner. Applicant canceled claims in this response solely to facilitate expeditious prosecution of this application. Applicant traverses all rejections and respectfully reserves the right to pursue the earlier-presented claims and additional claims, in one or more continuing applications.

### **I. Examiner Interview**

Applicant thanks Examiners Liou and Hayes for the interview held on April 21, 2008 between the Applicant's representatives and the Examiners. The Examiners and the undersigned attorney discussed the objection to claim 15. Applicant indicated that claim 15 will be canceled. Examiners stated the objection will be withdrawn.

Additionally, the 103 rejection was discussed. Applicant indicated that new claims will be presented with additional features that distinguish the claimed invention over the prior art. Examiners acknowledged the additional claim features are not taught in the cited reference. However, no further agreement was reached regarding this rejection. Therefore, Applicant addresses this rejection accordingly.

### **II. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected claims 6-8 and 14-18 under 35 U.S.C. § 103 as obvious over *Grimes*, "Smart Cards Help Operators Build Better Customer Relations", Nation's Restaurant News, March 30, 1998, No. 13, Vol. 32, pg. 54 (hereinafter "*Grimes*") in view of *Elliott* (U.S. 6,366,220). Applicant has canceled claims 6-8 and 14-18. Therefore, with respect to these claims this rejection is moot.

### III. New Claims 19-29

Applicant has added new claims 19-29. None of the cited references, alone or in combination, teach or suggest the claimed features presented in the claims. Claim 19 is a representative claim in this grouping of claims. Claim 19 is as follows:

19. A computer implemented method for communicating dining preferences of a customer to an establishment, the computer implemented method comprising:
- detecting, by a data processing system, a portable storage device associated with a customer, wherein the portable storage device comprises a first set of dining preferences for a first restaurant in a set of different and unrelated restaurants and a second set of dining preference for a second restaurant in the set of different and unrelated restaurants, wherein the first set of dining preferences comprises a first selection of food items and food preparation preferences associated with the first restaurant, wherein the second set of dining preferences comprises a second selection of food items and food preparation preferences, wherein the first set of dining preferences and the second set of dining preferences are stored in a memory of the portable storage device by corresponding restaurant name, in response to receiving a personal identification certificate;
  - reading, by the data processing system, the first set of dining preferences from the portable storage device;
  - displaying the first set of dining preferences, on a display in the first restaurant, for order verification, wherein the second set of dining preferences stored on the portable storage device are not displayed;
  - responsive to receiving a verified first set of dining preferences, generating a food order using the first set of dining preference; and
  - storing the first set of dining preferences in the memory of the portable storage device and on an order system in the first restaurant.

*Grimes* describes a specific type of smart card that is referred to as a fixed-function or proprietary card. It is well known in the art that fixed-function cards are associated with a *single* issuing entity, such as a financial institution or a retail establishment. The data stored on these fixed-function or proprietary card relates to the issuing entity only. *Grimes* teaches away from the presently claimed invention because *Grimes* asserts that given the questions of security and information access, it is unlikely that a smart card will contain multiple types of disparate information on a single smart card. *Grimes* paragraph 0005-0006. Moreover, the Examiner admits that *Grimes* does not teach all the features of the claimed invention. However, the Examiner asserts that *Elliott* makes up for the deficiencies of *Grimes*.

*Elliott* teaches reading menu information from an RF tag that is attached to a customer vehicle. The menu information is read as the customer vehicle passes an order station. *Elliott* teaches away from the presently claimed invention because the RF tag is associated to a given restaurant. The restaurant uses the RF tag identifier to identify a customer's selected menu items. Such a practice is in contradistinction to the presently claimed invention, which teaches a portable storage device that contains dining

preferences for a set of different and unrelated restaurants. Because the tag identifier is associated with a given restaurant, the tag identifier would be inoperable at different unrelated restaurant. Therefore, nothing in *Elliott* teaches the features as claimed in claims 19-29.

Moreover, *Elliott* fails to make up for the deficiencies in *Grimes*. The RF tag taught in *Elliott* is similar to the type of fixed-function card taught in *Grimes*, but due to the fixed function or proprietary nature of the RF tag and the fixed-function card, neither are operable between a multitude of different and unrelated restaurants. Therefore, no *prima facie* obviousness rejection can be stated against claims 19-29 in view of the combination of references considered as a whole.

#### **IV. Conclusion**

It is respectfully urged that the subject application is patentable over the cited reference(s) and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: April 21, 2008

Respectfully submitted,

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